



Paper No. 33

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SEP 26 2001

OFFICE OF PETITIONS

In re Application of :
DeBonte, Fan, and Loh :
Application No. 08/572,027 : DECISION REFUSING STATUS
Filed: 14 December, 1995 :
Attorney's Docket No. A21-535.1007 :

This is a decision on the petition filed on 15 May, 2001, under 37 CFR 1.183, which is being treated as (1) a petition under 37 CFR 1.48(a) to amend the inventive entity by the addition of Guo-Hua Miao (Miao) and the deletion of Willie H.-T. Loh (Loh), (2) a petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.48(a)(1) which requires a statement from the person being added (Miao), (3) a petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.63 and 1.67, which require that a named inventor execute a supplemental declaration, and (4) as authorized by 37 CFR 1.48(a)(2) a petition under 37 CFR 1.47(a), to accept the declaration filed on 15 May, 2001, which lacks the signature of Miao.

The petition is dismissed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. FAILURE TO TIMELY RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION. The reconsideration request should include a cover letter entitled "Renewed Petitions Under 37 CFR 1.48, 1.183, and 1.47."

The above-identified application was filed on 14 December, 1995, without an oath or declaration. On 25 March, 1996, a declaration was filed naming Lorin H. DeBonte, Zhegong Fan, and Willie H.-T. Loh as joint inventors.

On 15 May, 2001, the present petition was filed, whereby petitioners request that Miao be added and Loh be deleted as a named inventor. Petitioners also request waiver of the rules in that Miao refuses to sign the declaration and the statement of lack of deceptive intent as required by 37 CFR 1.48. Furthermore, petitioners request waiver of the rules in that an inventor who signed the original declaration, Fan, refuses to sign the supplemental declaration naming Miao as a joint inventor.

Petition Under 37 CFR 1.183 to waive 37 CFR 1.48(a).

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by: (1) a petition including a statement from each person being added and from each person being deleted as an inventor that the error occurred without deceptive intention on his or her part; (2) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43, or 1.47; (3) the fee set forth in 37 CFR 1.17(I); and (4) the written consent of any assignee, if any of the originally named inventors has executed an assignment.

The present petition lacks items (1), (2), and (4) with respect to Miao. The petition also lacks item (4) with respect to Loh.

In response to item (1), the petition lacks a statement of lack of deceptive intention on the part of Miao, the inventor being added. In response to item (2), the supplemental declaration lacks the signature of Miao. It is noted that although petitioners state that Fan refuses to sign the supplemental declaration, a copy of the declaration naming DeBonte, Miao, and Fan as joint inventors was filed on 15 May, 2001, apparently with Fan's signature. Accordingly, it appears that Fan has in fact signed the supplemental declaration. Petitioner's must notify the Office if this is an incorrect interpretation.

37 CFR 1.183 provides that in an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed.¹

¹ MPEP 201.03(B).

Petitioners must show that the inability to obtain the statement from Miao is, notwithstanding the exercise of reasonable care and diligence, due to circumstances beyond their control. Under the circumstances of this case, petitioners should proceed as noted in more detail *infra* to make their showing in support of their request for waiver.

In regards to item (4), petitioners have not provided proof of authority of the person signing the statement of consent to sign on behalf of the assignee. The statement must be either signed by an officer of the corporation (president, vice president, secretary, or treasurer), or petitioners must present proof of the authority of the person signing on behalf of the corporation in accordance with 37 CFR 3.73(b).

Petition Under 37 CFR 1.47(a).

Likewise, the entire showing of record, considered also under 37 CFR 1.47, does not currently warrant acceptance of the declarations under 37 CFR 1.63 and 37 CFR 1.43(a)(2), filed on 12 March, 2001, so as to amend the inventive entity of record under 37 CFR 1.43(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, drawings, and the declaration); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The present petition lacks items (1).

In respect to item (1), the showing of record is insufficient to establish that Miao refused to sign the declaration after being presented with a copy of the application. Although a letter was submitted with the petition showing that a copy of the application and statement of lack of deceptive intent were mailed to Miao at E.I. DuPont de Nemours & Company (DuPont), the letter does not constitute a *bona fide* attempt to present the application papers to Miao because the letter was not set to the last known address of the non-signing inventor. It is further noted that no street address was listed on the letter, however,

²See MPEP 409.03(d).

and there is no evidence that Miao ever received the letter.

Petitioners should send or give a copy of the application papers (specification, including claims, drawings, if any, and the declaration) and the statement of lack of deceptive intent to the inventor at his last known address. Petitioners may submit proof in the form of a copy of the cover letter transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Additionally, proof that the inventor refuses to sign the Declaration and the statement of lack of deceptive intention after being presented with the application must be provided.³ If there is a written refusal, petitioners must provide a copy of the written refusal. If the refusal is made orally to a person, then the person must provide details of the refusal in an affidavit or declaration of facts.

Petition Under 37 CFR 1.183 to waive 37 CFR 1.63 and 1.64.

It is noted that although petitioners state that Fan refuses to sign the supplemental declaration, a copy of the declaration naming DeBonte, Miao, and Fan as joint inventors filed on 15 May, 2001, appears to bear Fan's signature. Accordingly, it appears that Fan has in fact signed the supplemental declaration. Petitioners must notify the Office if this is an incorrect interpretation.

Further correspondence with respect to this matter should be addressed as follows:

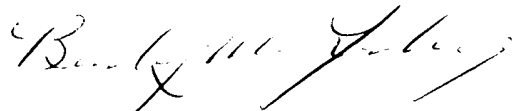
By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

³MPEP 409.03(d).

Telephone inquiries concerning this matter may be directed to
Petitions Attorney Douglas I. Wood, at (703)308-6918.

A handwritten signature in cursive script, appearing to read "Beverly M. Flanagan".

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy